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EXAMINER	
HOSSAIN, FARZANA E	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/870,296	NASHIDA ET AL.	
	Examiner	Art Unit	
	FARZANA HOSSAIN	2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 March 2011*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-6 and 8-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-6 and 8-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This office action is in response to communications filed 03/04/2011. Claims 1, 2, 4-6, and 8-11 are pending. Claims 1, 4, 8 and 9 are amended. Claims 2, 5, 6, 10 and 11 have been previously presented. Claims 3 and 7 are cancelled.

Response to Arguments

2. Applicant's arguments filed 03/04/2011 have been fully considered but they are not persuasive.

Regarding Claim 1, the applicant argues that Kuroda does not teach a connection means connecting with an external device, issuing a recording substitution request via the Internet by a connection means or having an external device record a program received from a distribution center upon receipt of a request based upon a failure in the recording system, the external device separately receives a program a distribution center independently of the recording system, connection means connecting via internet to the external device and the external device receiving a program via unidirectional means (Page 2-3). The applicant argues showing a screen to select another device (Pages 3-4). The applicant argues that Kuroda discloses temporary storage device not issuing a recording substitution request via internet by a connection

means or external device to record a program received from a distribution center (Page 4). The applicant argues that Kuroda does not disclose that insufficient capacity does not mean failure (Page 4). The applicant also discloses that there is a peripheral device not an external device. The applicant argues that Ellis does not teach argues a connection means connecting with an external device, the external device is external to the recording system, the external device separately receives a program fro ma a distribution center independently of the recording system, the external device receiving a program via unidirectional means (Page 5). The applicant makes further arguments in relation to these arguments (Pages 1-8).

In response to the arguments, the examiner respectfully disagrees. The examiner has stated in the office action that Kuroda is silent for connection means for connecting via Internet with an external device which is external to the recording system, the external device separately receiving the program, via unidirectional communication from the distribution center independently of the recording system means for issuing a recording request to the external device for recording the program via the wide network by the connection means, wherein the external device records the program receiving from the distribution center upon receipt of the recording request.

Kuroda discloses determination means for determining a failure in the local storage means or based on lack of storage space the storage means fails to record the program requested to be recorded and/or reserved, there is selection of another external device as there is a failure to record the entire program (Column 5, lines 60-65); means for issuing a recording substitution request to an external device for

recording the program via the connection means in response to the determination means determining the failure (Figure 22, Figure 7). Kuroda discloses transmitting programs via broadcast wave to the user or a program is sent via unidirectional communication (Column 6, lines 58-65). Kuroda discloses the broadcast is received via the tuner (Figure 1, 102, Figure 9, 801, Column 6, lines 58-65). Kuroda discloses multiple storage devices. The applicant's argument that the device to record is not external but peripheral is not persuasive as the peripheral device is external. The examiner would like to note that Ellis discloses external device via the Internet. Ellis discloses multiple storage devices, including an external storage device, wherein the client is connected to the external storage device via the Internet. Ellis discloses the remote media server receives the programs from the distribution equipment (Page 5, paragraph 0088). Ellis discloses that the user requests to record at the remote media server via Internet (Pages 4-5, paragraphs 0070, 0072, 0074, Page 8, paragraph 0105). Ellis discloses the distribution equipment transmits via unidirectional communication. Ellis discloses the external device separately receiving the program, via unidirectional communication from the distribution center independently of the recording system (Page 6, paragraphs 0084-0085, 0088, Page 5, paragraph 0075, Page 4, paragraphs 0064, 0065, Figures 2c, 2d, 24, 20), means for issuing a recording request to the external device for recording the program via the Internet by the connection means (Page 5, paragraphs 0074-0075); wherein the external device records the program receiving from the distribution center upon receipt of the recording request (Page 6, paragraphs 0084-0085, 0088, Page 4, paragraphs 0065, Figures 2c, 2d, 24, 20). Ellis discloses the

user device receives via unidirectional communication from the distribution center (Page 4, paragraphs 0064-0065, Page 3, paragraph 0060). Ellis discloses means for accepting a request to record and/or reserve a program (Page 6, paragraph 0084-0086, Figure 5); local storage means for recording the program (Page 6, paragraph 0086, Figure 7, 32, 31, 29); connection means for connecting via Internet with an external device which is external to the recording system (Page 6, paragraphs 0084, Page 5, paragraph 0075, Page 4, paragraphs 0065, Figures 2a, 2c, 2d, 24, 20), means for issuing a recording request to the external device for recording the program via the Internet by the connection means (Page 6, paragraphs 0084-0085, Pages 4-5, paragraphs 0065, 0070, 0072, 0074, Figures 2c, 2d, 24, 20), the external device separately receiving the program, via unidirectional communication from the distribution center independently of the recording system (Page 6, paragraphs 0084-0085, 0088 Page 5, paragraph 0075, Page 4, paragraphs 0064, 0065, Figures 2c, 2d, 24,), means for issuing a recording request to the external device for recording the program via the Internet by the connection means (Pages 4-5, paragraphs 0070, 0072, 0074, Page 8, paragraph 0105) wherein the external device records the program receiving from the distribution center upon receipt of the recording request (Page 6, paragraphs 0084-0085, 0088, Page 4, paragraphs 0065, Figures 2c, 2d, 24, 20).

The combination of Kuroda and Ellis disclose the limitations. Furthermore, in *KSR International Co. Teleflex Inc.*, 82 USPQ2d 1385, 1395 (2007), the Court found that if all the claimed elements are known in the prior art then one skilled in the art could have combined the elements as claimed by known methods with no change in their

respective functions, and the combination would have yield predictable results to one of ordinary skill in the art at the time of the invention.

3. The applicant did not specifically argue the dependent claims.

See response above.

4. Regarding claims 4-6 and 9, the applicant argues that nothing in Kuroda, Ellis or Zigmond teaches recording both content (Pages 8-13). The applicant makes similar arguments for Kuroda and Ellis in the arguments of Claim 1 (Pages 1-8, see arguments above). The applicant argues that Kuroda, Ellis and Zigmond does not disclose a) responding to a recording request from an external device, obtaining advertising information from another external device, storing program content and advertising information in a second recording advertising information is stored as an insert into the recorded program content or stored as a substitute for the original commercial information (Page 9-14).

In response to the argument, the examiner respectfully disagrees. See response to arguments of Claim 1. Zigmond discloses recording substitution portion (ad insertion device performing ad insertion via repository and switching unit) (Figure 5, Column 15, lines 24-27, 31-34) configured to one of a) stores a recorded program in the first storage means (Column 14, lines 9-11) and the advertising information in the second storage means for the external devices (Figure 5, 82, Column 11, lines 31-65), the advertising information stored as an insert in the recorded program in addition to original

commercial information included in the recorded program as only obsolete ads will be replaced (Column 14, lines 1-12) and b) stores the recorded program stored in the first storage means (Column 14, lines 9-11) and the advertising information as a substitute (Column 15, lines 31-34) for the original information in the recorded program stored in the storage means (Column 7, lines 10-11, 13-20, Column 15, lines 31-34, Column 14, lines 1-12). Zigmond discloses recording both the program and ads (Column 14, lines 9-11). Zigmond discloses a first storage means and a second storage means. Kuroda disclose a recording system for recording and/or reserving a program (Figure 1) and a recording substitution system for substitutionally recording a program (Figure 1), comprising: means for accepting a request to record and/or reserve a program (Column 4, lines 18-50); first storage means for recording a program (Column 4, lines 18-50, Figure 2, 103, 105); connection means for connecting with external devices (Column 4, lines 38-44, Column 5, lines 60-65); means for receiving a program (Figure 1, Figure 2); recording substitution means for responding to the reception of a recording substitution request from at least one of the external devices via the connection means for receiving and recording means for issuing a recording substitution request to an external device for recording the program via the connection means (Figure 22, Figure 7). Ellis discloses connection means for connecting via a wide area network with an external device which is external to the recording system (Page 6, paragraphs 0084, Page 4, paragraphs 0065, Figures 2c, 2d, 24, 20), means for issuing a recording request to the external device for recording the program via the wide network by the connection means (Page 6, paragraphs 0084-0085, Page 4, paragraphs 0065, Figures 2c, 2d, 24,

20) and first storage means for recording program content of the program (Page 4, paragraph 0060, Figure 7, 31, 32, Page 8, paragraphs 0100, 0102) and second storage means for storing the program content with advertising information (Page 4, paragraph 0060, Figure 7, 29, 32, Page 9, paragraph 0109, Page 8, paragraph 0100).

Specifically regarding Claim 9, the limitation receiving program content with advertising content independent of distribution station is interpreted as received by another means and not directly from the distribution center. Ellis discloses first storage means for recording program content of the program (Page 4, paragraph 0060, Figure 7, 31, 32, Page 8, paragraphs 0100, 0102) and second storage means for storing the program content with advertising information independently of the distribution station or receiving from set top box. Zigmond discloses advertising content received independently of the distribution center (Figure 5, 86, Figure 4, 62, Column 11, lines 31-65).

The applicant did not specifically argue any of the dependent claims.

See response above.

Regarding Claim 8, the applicant argues the limitations with Claim 1 (Pages 15-18). The applicant argues that Lawler does not disclose a connection portion to connect with an external storage device, the external storage device is external to the recording system, the external storage device separately receives the program from the distribution center independent of the recording system and further that Lawler does not teach a connection portion connecting to an external storage device, external to the

recording stem, where the external storage device separately receives the program from the distribution center independently of the recording system, issue portion configured to automatically issue a recording substitution request to the external storage device (Pages 18-19).

In response to the argument, the examiner respectfully disagrees. See response to arguments of Claim 1. Lawler discloses means for accepting a request to record and/or reserve a program (Column 12, lines 29-31, 58-61); local storage means for recording the program (Figure 2, 23); connection means for connecting via a wide area network with an external storage device which is external to the recording system (Column 5, lines 28-31, Figure 1, 14, Column 12, lines 29-31, 58-61, Column 13, 8-12, 26-36), issue portion for automatically issuing a recording request to the external storage device for recording the program via the wide network by the connection means (Column 12, lines 29-31, 58-61, Column 13, 8-12, 26-36

Although the applicant did not argue Ellis, the examiner clearly placed in the arguments under number 3, bottom of page 4 of the non final rejection that Claim 8 was rejected by Kuroda in view of Lawler and Ellis. There was a typographical error in the heading but the rejection is the same as the non final rejection - Kuroda in view of Lawler and Ellis. The rejection was rejected with motivational and obvious statement of Kuroda, Lawler and Ellis. The examiner will apply the same arguments of Claim 8 and Claim 1 to the rejection. Ellis discloses the external storage device separately receives the program via the unidirectional communication from the distribution center independently of the recording system (Page 6, paragraphs 0084-0085, 0088, Page 5,

paragraph 0075, Page 4, paragraphs 0064, 0065, Figures 2c, 2d, 24), means for issuing a recording request to the external device for recording the program via the Internet by the connection means (Pages 4-5, paragraphs 0070, 0072, 0074, Page 8, paragraph 0105) wherein the external device records the program receiving from the distribution center upon receipt of the recording request (Page 6, paragraphs 0084-0085, 0088, Page 4, paragraphs 0065, Figures 2c, 2d, 24, 20).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda (US 6,311,011) in view of Ellis et al (US 2003/0149988 and hereafter referred to as “Ellis”).

Regarding Claim 1, Kuroda disclose a recording system for recording and/or reserving a program (Figure 1) and a recording substitution system for substitutionally recording a program (Figure 1), comprising:

Receiving means for receiving, via unidirectional communication, the program from a distribution center external to the recording system (Column 6, lines 55-65);

means for accepting a request to record and/or reserve a program (Column 4, lines 18-50); local storage means for recording a program (Column 4, lines 18-50, Figure 2, 103, 105);

connection means for connecting with an external device (Column 4, lines 38-44, Column 5, lines 60-65); means for receiving a program (Figure 1, Figure 2);

determination means for determining a failure in the local storage means or based on lack of storage space the storage means fails to record the program requested to be recorded and/or reserved (Column 5, lines 60-65);

means for issuing a recording substitution request to an external device for recording the program via the connection means in response to the determination means determining the failure (Figure 22, Figure 7). Kuroda discloses recording substitution means or the recorder/player for responding to reception of a recording substitution request via connection means and receiving and recording a corresponding in the storage means (Column 5, lines 60-65, Figure 7) and the external device records the program receiving from the distribution center upon receipt of the recording substitution request (Figure 22, Figure 7). Kuroda discloses the recording system or recording substitution system receives and records television programs in the storage means or the external device.

Kuroda is silent for connection means for connecting via Internet with an external device which is external to the recording system, the external device separately receiving the program, via unidirectional communication from the distribution center independently of the recording system means for issuing a recording request to the

external device for recording the program via the wide network by the connection means, wherein the external device records the program receiving from the distribution center upon receipt of the recording request.

In analogous art, Ellis discloses means for accepting a request to record and/or reserve a program (Page 6, paragraph 0084-0086, Figure 5); local storage means for recording the program (Page 6, paragraph 0086, Figure 7, 32, 31, 29); connection means for connecting via Internet with an external device which is external to the recording system (Page 6, paragraphs 0084, Page 5, paragraph 0075, Page 4, paragraphs 0065, Figures 2a, 2c, 2d, 24, 20), means for issuing a recording request to the external device for recording the program via the Internet by the connection means (Page 6, paragraphs 0084-0085, Pages 4-5, paragraphs 0065, 0070, 0072, 0074, Figures 2c, 2d, 24, 20), the external device separately receiving the program, via unidirectional communication from the distribution center independently of the recording system (Page 6, paragraphs 0084-0085, 0088 Page 5, paragraph 0075, Page 4, paragraphs 0064, 0065, Figures 2c, 2d, 24,), means for issuing a recording request to the external device for recording the program via the Internet by the connection means (Pages 4-5, paragraphs 0070, 0072, 0074, Page 8, paragraph 0105) wherein the external device records the program receiving from the distribution center upon receipt of the recording request (Page 6, paragraphs 0084-0085, 0088, Page 4, paragraphs 0065, Figures 2c, 2d, 24, 20). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination to include remaining limitations as taught by Ellis in order to provide make it convenient for users

to play programs on demand instead of the users having to wait for a previously scheduled program to possibly repeat at a time scheduled by the provider (Page 1, paragraphs 0009-0011) as disclosed by Ellis.

Furthermore, in *KSR International Co. Teleflex Inc.*, 82 USPQ2d 1385, 1395 (2007), the Court found that if all the claimed elements are known in the prior art then one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yield predictable results to one of ordinary skill in the art at the time of the invention.

Regarding Claim 2, Kuroda and Ellis disclose all the limitations of Claim 1. Kuroda discloses the determination means generates a negative result when a remaining capacity of the storage means is not sufficient for recording a broadcast program requested to be recorded and/or reserved (Figure 7, Column 5, lines 60-65).

7. Claims 4-6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda in view of Ellis and Zigmond et al (US 6,698,020 and hereafter referred to as “Zigmond”).

Regarding Claim 4, Kuroda disclose a recording system for recording and/or reserving a program (Figure 1) and a recording substitution system for substitutionally recording a program (Figure 1), comprising: means for accepting a request to record and/or reserve a program (Column 4, lines 18-50); first storage means for recording a program content of the program (Column 4, lines 18-50, Figure 2, 103, 105); connection means for connecting with external devices (Column 4, lines 38-44, Column 5, lines 60-

65); means for receiving a program from a broadcast wave via unidirectional communication (Figure 1, Figure 2, Column 6, lines 58-65); recording substitution means for responding to the reception of a recording substitution request from at least one of the external devices via the connection means for receiving and recording means for recording the program content (Figure 22, Figure 7).

Kuroda discloses recording substitution means or the recorder/player for responding to reception of a recording substitution request via connection means and receiving and recording a corresponding in the storage means (Column 5, lines 60-65, Figure 7). Kuroda discloses the recording system or recording substitution system receives and records television programs in the first storage means or the external device, which necessarily includes commercials.

Kuroda is silent on means for receiving the program from the distribution station, second storage means for storing customized program content, user information management means for storing user information about each requesting origin, and obtaining advertising information appropriate for a user attribute of the requesting origin via the connection means and recording substitution means is configured to one of a) stores the advertising information in the storage means as an insert in a recorded program content stored in the storage means in addition to original commercial information included in the recorded program content and b) stores the advertising information as a substitute for the original information in the recorded program content. Kuroda is silent for connection means for connecting via a wide area network with external devices which is external to the recording system, means for issuing a

recording request from at least one of the external devices via connection means for receiving and recording the program via the wide network by the connection means and for receiving and recording a program corresponding to the request in the storage means.

In analogous art, Ellis discloses means for accepting a request to record and/or reserve a program (Page 6, paragraph 0084-0086, Figure 5); local storage means for recording the program (Page 6, paragraph 0086, Figure 7, 32, 31, 29); connection means for connecting via a wide area network with external devices which is external to the recording system including remote media server for recording programs, television distribution facility for distributing television, program, advertisements, video and/or program guide data (Page 3, paragraph 0060, Page 4, paragraph 0064, 0066, 0069-0070, Figure 2c, 61, 24, Figure 2d, 61, 24), means for issuing a recording request from at least one of the external devices via connection means for receiving and recording the program via the Internet by the connection means and for receiving and recording a program corresponding to the request in the storage means (Page 6, paragraphs 0084-0086, 0088, Page 8, paragraph 0105, Page 4-5, paragraphs 0065, 0070, 0072, 0074 Figures 2c, 2d, 24, 20), first storage means for recording program content of the program (Page 4, paragraph 0060, Figure 7, 31, 32, Page 8, paragraphs 0100, 0102) and second storage means for storing the program content with advertising information (Page 4, paragraph 0060, Figure 7, 29, 32, Page 9, paragraph 0109, Page 8, paragraph 0100).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination to include connection means for connecting via a wide area network with external devices which is external to the recording system including remote media server for recording programs, television distribution facility for distributing television, program, advertisements, video and/or program guide data (Page 3, paragraph 0060, Page 4, paragraph 0064, 0066, 0069-0070, Figure 2c, 61, 24, Figure 2d, 61, 24), means for issuing a recording request from at least one of the external devices via connection means for receiving and recording the program via the wide network by the connection means and for receiving and recording a program corresponding to the request in the storage means (Page 6, paragraphs 0084-0086, 0088, Page 4-5, paragraphs 0065, 0070, 0072, 0074, Page8, paragraph 0105, Figures 2c, 2d, 24, 20); second storage means for storing the program content with advertising information (Page 4, paragraph 0060, Figure 7, 29, 32, Page 9, paragraph 0109, Page 8, paragraph 0100) as taught by Ellis in order to provide make it convenient for users to play programs on demand instead of the users having to wait for a previously scheduled program to possibly repeat at a time scheduled by the provider (Page 1, paragraphs 0009-0011) as disclosed by Ellis.

The combination is silent on second storage means for storing the program content with advertising information selected for at least one of the external devices; user information management means for storing user information about each requesting origin, and obtaining advertising information appropriate for a user attribute of the requesting origin from another external device or advertising source via the wide area

network by the connection means and the recording substitution means or ad insertion device configured to one of a) stores a recorded program in the first storage means and the advertising information in the second storage means, the advertising information stored as an insert in the recorded program in addition to original commercial information included in the recorded program as only obsolete ads will be replaced and b) stores the recorded program stored in the first storage means and the advertising information as a substitute for the original information in the recorded program content stored in the storage means.

In analogous art, Zigmond discloses connection means to external devices (Figure 4, 62, 66, Column 9, lines 39-55); first storage means for recording the program (Column 14, lines 9-11); second storage means for storing advertising information selected for at least one of the external devices (Column 13, lines 38-57, Column 11, lines 31-65, Column 15, lines 25-30); user information management means for storing user information about each requesting origin (Figure 5, 82), and obtaining advertising information appropriate for a user attribute of the requesting origin from another external device or advertising source via the wide area network by the connection means (Figure 5, Figure 6, Column 7, lines 9-12, Column 11, lines 31-65, Figure 4, 62, 66, Column 9, lines 39-55, Column 14, lines 4-6) and the recording substitution means or ad insertion device (Figure 5, 80, 86, 83, 82, 81). Zigmond discloses recording substitution portion (ad insertion device performing ad insertion via repository and switching unit) (Figure 5, Column 15, lines 24-27, 31-34) configured to one of a) stores a recorded program in the first storage means (Column 14, lines 9-11) and the advertising information in the

second storage means (Figure 5, 82), the advertising information stored as an insert in the recorded program in addition to original commercial information included in the recorded program as only obsolete ads will be replaced (Column 14, lines 1-12) and b) stores the recorded program stored in the first storage means (Column 14, lines 9-11) and the advertising information as a substitute (Column 15, lines 31-34) for the original information in the recorded program stored in the storage means (Column 7, lines 10-11, 13-20, Column 15, lines 31-34, Column 14, lines 1-12).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination to include second storage means for storing program content with advertising information selected for at least one of the external devices (Figure 5, 86, Column 13, lines 38-57, Column 14, lines 9-12, Column 15, lines 25-30); user information management means for storing user information about each requesting origin (Figure 5, 82), and obtaining advertising information appropriate for a user attribute of the requesting origin from another external device or advertising source via the wide area network by the connection means (Figure 5, Figure 6, Column 7, lines 9-12, Column 11, lines 31-65, Figure 4, 62, 66, Column 9, lines 39-55) and the recording substitution means or ad insertion device (Figure 5, 80, 86, 83, 82, 81) configured to one of a) stores a recorded program in the first storage means (Column 14, lines 9-11) and the advertising information in the second storage means (Figure 5, 82), the advertising information stored as an insert in the recorded program in addition to original commercial information included in the recorded program as only obsolete ads will be replaced (Column 14, lines 1-12) and b) stores the recorded

program stored in the first storage means (Column 14, lines 9-11) and the advertising information as a substitute (Column 15, lines 31-34) for the original information in the recorded program stored in the storage means (Column 7, lines 10-11, 13-20, Column 15, lines 31-34, Column 14, lines 1-12) as taught by Zigmond in order to provide advertisements that are more interesting to the viewer for premium payment from the advertiser (Column 1, lines 23-35) as disclosed by Zigmond.

Furthermore, the *KSR* Court found that if all the claimed elements are known in the prior art then one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yield predictable results to one of ordinary skill in the art at the time of the invention. *KSR*, 82 USPQ2d at 1395.

Regarding Claim 5, Kuroda, Ellis and Zigmond disclose all the limitations of Claim 4. Kuroda discloses when the recorder is connected with the Internet; the video recorder may store signals via World Wide Web in the temporary storage device (Column 12, lines 28-44). It is noted that the World Wide Web records data from a plurality of external devices (plurality of users) and the substitution means is located upstream from the user and records program per users' requests.

Regarding Claim 6, Kuroda, Ellis and Zigmond disclose all the limitations of Claim 4. Kuroda discloses comprising user information management means for storing user information about each requesting origin, wherein the recording substitution means records a broadcast program in a format appropriate for a user attribute of the

requesting origin including HDD format, DVD format or VCR format (Figure 1, 105, Figure 7, Figure 22).

Regarding Claim 9, Kuroda disclose a recording substitution system for substitutionally recording a program (Figure 1), comprising:

receiving portion configured to receive a program via unidirectional communication (Column 6, lines 58-65, Figure 1, Figure 2);

a first storage portion configured to record a program (Column 4, lines 18-50, Figure 2, 103, 105);

connection portion configured to connect with external devices (Column 4, lines 38-44, Column 5, lines 60-65);

recording substitution portion configured to respond to the reception of a recording substitution request from at least one of the external devices via the connection means for receiving and recording means for issuing a recording substitution request to an external device for recording the program via the connection portion (Figure 22, Figure 7).

Kuroda discloses recording substitution means or the recorder/player for responding to reception of a recording substitution request via connection means and receiving and recording a corresponding in the storage means (Column 5, lines 60-65, Figure 7). Kuroda discloses the recording system or recording substitution system receives and records television programs in the storage means or the external device, which necessarily includes commercials.

Kuroda is silent for a second storage portion configured to store customized program content; connection portion for connecting via an Internet with external devices, means for responding to reception of a recording request from at least one of the external devices via connection means for receiving and recording the program via the Internet by the connection means. Kuroda is silent on recording substitution means is configured to one of a) stores the new advertising content, received from another external device, in the storage portion as a replacement for advertising content in the recorded program stored in the storage portion and b) store additional advertising content, received from the another external device, in the storage portion as an insert in the recorded program stored in the storage portion.

In analogous art, Ellis discloses means for accepting a request to record and/or reserve a program (Page 6, paragraph 0084-0086, Figure 5); local storage means for recording the program (Page 6, paragraph 0086, Figure 7, 32, 31, 29); connection means for connecting via a Internet with external devices which is external to the recording system including remote media server for recording programs, television distribution facility for distributing television, program, advertisements, video and/or program guide data (Page 3, paragraph 0060, Pages 4-5, paragraph 0064, 0066, 0069-0070, 0072, 0074, Figure 2c, 61, 24, Figure 2d, 61, 24), means for issuing a recording request from at least one of the external devices via connection means for receiving and recording the program via the Internet by the connection means and for receiving and recording a program corresponding to the request in the storage means (Page 6, paragraphs 0084-0086, 0088, Pages 4-5, paragraphs 0065, 0070, 0072, 0074, Page 8,

paragraph 0105, Figures 2c, 2d, 24, 20); first storage means for recording program content of the program (Page 4, paragraph 0060, Figure 7, 31, 32, Page 8, paragraphs 0100, 0102) and second storage means for storing the program content with advertising information independent of the distribution station or receiving from set top box (Page 4, paragraph 0060, Figure 7, 29, 32, Page 9, paragraph 0109, Page 8, paragraph 0100, Page 6, paragraphs 0084-0086, 0088).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuroda to include connection portion for connecting via Internet with external devices which is external to the recording system including remote media server for recording programs, television distribution facility for distributing television, program, advertisements, video and/or program guide data (Page 6, paragraphs 0084-0086, 0088, Pages 4-5, paragraphs 0065, 0070, 0072, 0074, Page 8, paragraph 0105, Figures 2c, 2d, 24, 2), means for issuing a recording request from at least one of the external devices via connection means (Page 6, paragraphs 0084-0086, Page 4, paragraphs 0065, Figures 2c, 2d, 24, 20); first storage means for recording program content of the program (Page 4, paragraph 0060, Figure 7, 31, 32, Page 8, paragraphs 0100, 0102) and second storage means for storing the program content with advertising information independent of the distribution station or receiving from set top box as taught by Ellis in order to provide make it convenient for users to play programs on demand instead of the users having to wait for a previously scheduled program to possibly repeat at a time scheduled by the provider (Page 1, paragraphs 0009-0011) as disclosed by Ellis.

The combination is silent on second storage means for storing customized program content; and the recording substitution means or ad insertion device configured to one of is configured to one of a) store a recorded program in the first storage means and the new advertising content, received from another external device, as a replacement for advertising content in the recorded program stored in the storage and b) store the recorded program stored in the first storage portion and additional advertising content, received from the another external device, in the second storage portion, the additional advertising content stored as an insert in the recorded.

In analogous art, Zigmond discloses connection means to external devices (Figure 4, 62, 66, Column 9, lines 39-55); first storage means for recording the program (Column 14, lines 9-11); second storage means for storing advertising content independent of the distribution center (Figure 5, 86, Figure 4, 62, Column 11, lines 31-65, Column 13, lines 38-57, Column 15, lines 25-30); user information management means for storing user information about each requesting origin (Figure 5, 82), and obtaining advertising information appropriate for a user attribute of the requesting origin from another external device or advertising source via the wide area network by the connection means (Figure 5, Figure 6, Column 7, lines 9-12, Column 11, lines 31-65, Figure 4, 62, 66, Column 9, lines 39-55, Column 14, lines 4-6) and the recording substitution means or ad insertion device (Figure 5, 80, 86, 83, 82, 81). Zigmond discloses recording substitution portion (ad insertion device performing ad insertion via repository and switching unit) (Figure 5, Column 15, lines 24-27, 31-34) is configured to one of a) store a recorded program in the first storage means (Column 14, lines 9-11)

and the new advertising content (in the advertisement repository) Column 15, lines 31-34), received from another external device (Figure 4, 62), as a replacement for advertising content in the recorded program stored in the storage portion (Column 15, lines 30-33, Column 7, lines 10-11, 13-20, Column 15, lines 31-34, Column 14, lines 1-12) and b) store the recorded program stored in the first storage portion and additional advertising content, received from the another external device, in the second storage portion, the additional advertising content stored as an insert in the recorded program as only obsolete ads will be replaced (Column 14, lines 1-12).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination to include second storage means for storing advertising content independent of the distribution center (Figure 5, 86, Figure 4, 62, Column 11, lines 31-65, (Figure 5, 86, Column 13, lines 38-57, Column 15, lines 25-30); recording substitution portion (Figure 1, 85, Column 15, lines 24-27, 31-34) is configured to one of) store a recorded program in the first storage means (Column 14, lines 9-11) and the new advertising content (in the advertisement repository) Column 15, lines 31-34), received from another external device (Figure 4, 62), as a replacement for advertising content in the recorded program stored in the storage portion (Column 15, lines 30-33, Column 7, lines 10-11, 13-20, Column 15, lines 31-34, Column 14, lines 1-12) and b) store the recorded program stored in the first storage portion and additional advertising content, received from the another external device, in the second storage portion, the additional advertising content stored as an insert in the recorded program as only obsolete ads will be replaced (Column 14, lines

1-12) as taught by Zigmond in order to provide advertisements that are more interesting to the viewer for premium payment from the advertiser (Column 1, lines 23-35) as disclosed by Zigmond.

Furthermore, the *KSR* Court found that if all the claimed elements are known in the prior art then one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yield predictable results to one of ordinary skill in the art at the time of the invention. *KSR*, 82 USPQ2d at 1395.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda in view of Lawler et al (US 5,805,763 and hereafter referred to as "Lawler") and Ellis.

Regarding Claim 8, Kuroda disclose a recording system for recording and/or reserving a program (Figure 1) and a recording substitution system for substitutionally recording a program (Figure 1, Figure 2), comprising: receiving portion for receiving the program, via unidirectional communication, from a distribution center external to the recording system (Column 6, lines 55-65 a request accept portion configured to accept a request to record and/or reserve the program (Column 4, lines 18-50); local storage portion for recording a program (Column 4, lines 18-50, Figure 2, 103, 105, Figure 9, 812); connection portion for connecting with an external device (Column 4, lines 38-44, Column 5, lines 60-65); means for receiving a program (Figure 1, Figure 2); determination portion for determining a failure in the recording system in or based on lack of storage space the storage means fails to record the program requested to be

recorded and/or reserved (Column 5, lines 60-65); means for automatically issuing a recording substitution request to the external device for recording the program via the connection means in response to the determination portion determining the failure (Figure 22, Figure 7). Kuroda discloses recording substitution means or the recorder/player for responding to reception of a recording substitution request via connection means and receiving and recording a corresponding in the storage means (Column 5, lines 60-65, Figure 7). Kuroda discloses that external storage devices can be numerous external storage devices (Figure 2, 105, Figure 9, 821-823, Column 8, lines 25-32). Kuroda discloses if a user selects a program to be recorded and the local storage device runs out of space, the program is automatically not deleted by being moved to the external storage device (Figure 22, Column 12, lines 16-24). Therefore, Kuroda does not explicitly disclose automatically issuing recording request to an external storage device. Kuroda is silent for connection means for connecting via Internet with an external storage device which is external to the recording system, the external storage device separately receives the program via the unidirectional communication issue portion automatically issuing a recording request to the external storage device for recording the program via the Internet by the connection means.

In analogous art, Lawler discloses means for accepting a request to record and/or reserve a program (Column 12, lines 29-31, 58-61); local storage means for recording the program (Figure 2, 23); connection means for connecting via a wide area network with an external storage device which is external to the recording system (Column 5, lines 28-31, Figure 1, 14, Column 12, lines 29-31, 58-61, Column 13, 8-12,

26-36), issue portion for automatically issuing a recording request to the external storage device for recording the program via the wide network by the connection means (Column 12, lines 29-31, 58-61, Column 13, 8-12, 26-36). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuroda to include means for accepting a request to record and/or reserve a program (Column 12, lines 29-31, 58-61); local storage means for recording the program (Figure 2, 23); connection means for connecting via a wide area network with an external storage device which is external to the recording system (Column 5, lines 28-31, Figure 1, 14, Column 12, lines 29-31, 58-61, Column 13, 8-12, 26-36), issue portion for automatically issuing a recording request to the external storage device for recording the program via the wide network by the connection means (Column 12, lines 29-31, 58-61, Column 13, 8-12, 26-36) as taught by Lawler in order to provide allow users to access a single recorded program (Column 13, 8-12, 26-36) as disclosed by Lawler.

The combination is silent for that the external storage device separately receives the program via the unidirectional communication, wherein the external device records the program received upon receipt of the recording request.

In analogous art, Ellis discloses means for accepting a request to record and/or reserve a program (Page 6, paragraph 0084-0086, Figure 5); local storage means for recording the program (Page 6, paragraph 0086, Figure 7, 32, 31, 29); connection means for connecting via Internet with an external device which is external to the recording system (Page 6, paragraphs 0084, Page 5, paragraph 0075, Page 4,

paragraphs 0065, Figures 2a, 2c, 2d, 24, 20), means for issuing a recording request to the external device for recording the program via the Internet by the connection means (Page 6, paragraphs 0084-0085, Page 4, paragraphs 0065, Figures 2c, 2d, 24, 20), the external storage device separately receives the program via the unidirectional communication from the distribution center independently of the recording system (Page 6, paragraphs 0084-0085, 0088, Page 5, paragraph 0075, Page 4, paragraphs 0064, 0065, Figures 2c, 2d, 24), means for issuing a recording request to the external device for recording the program via the Internet by the connection means (Pages 4-5, paragraphs 0070, 0072, 0074, Page 8, paragraph 0105) wherein the external device records the program receiving from the distribution center upon receipt of the recording request (Page 6, paragraphs 0084-0085, 0088, Page 4, paragraphs 0065, Figures 2c, 2d, 24, 20). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination to include remaining limitations as taught by Ellis in order to provide make it convenient for users to play programs on demand instead of the users having to wait for a previously scheduled program to possibly repeat at a time scheduled by the provider (Page 1, paragraphs 0009-0011) as disclosed by Ellis.

Furthermore, the *KSR* Court found that if all the claimed elements are known in the prior art then one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yield predictable results to one of ordinary skill in the art at the time of the invention. *KSR*, 82 USPQ2d at 1395.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda in view of Ellis, as applied to Claim 1, further in view of Zigmond.

Regarding Claim 10, Kuroda and Ellis disclose all the limitations of Claim 1. Kuroda discloses receiving and recording television programs in the storage means or the external device, which necessarily includes commercials. Ellis discloses connection means for connecting via a Internet with external devices which is external to the recording system (Page 3, paragraph 0060, Page 4, paragraph 0064, 0066, 0069-0070, Figure 2c, 61, 24, Figure 2d, 61, 24), means for issuing a recording request from at least one of the external devices via connection means for receiving and recording the program via the Internet by the connection means and for receiving and recording a program corresponding to the request in the storage means (Page 6, paragraphs 0084-0086, Page 4, paragraphs 0065, Figures 2c, 2d, 24, 20). Ellis discloses external device includes user information management means (Page 6, paragraph 0082). Kuroda and Ellis is silent on a recording medium obtaining advertising information appropriate for a user attribute of the requesting origin via the connection means and one of a) inserts the advertising information in a recorded program stored in the storage means in addition to original commercial information included in the recorded program and b) substitutes the advertising information for the original information in the recorded program.

In analogous art, Zigmond discloses any recording medium comprising recording substitution means obtaining advertising information appropriate for a user attribute of the requesting origin by the connection means (Figure 5, Figure 6, Column 7, lines 9-12,

Column 11, lines 31-65, Figure 4, 62, 66, Column 9, lines 39-55). Zigmond discloses recording substitution means (ad insertion device performing ad insertion via repository and switching unit) (Figure 5, Column 15, lines 24-27, 31-34) configured to one of a) inserts the advertising information in a recorded program in addition to original commercial information or any commercials that an advertiser can specify to be shown during a particular program and only some commercials have to be replaced in a recorded program so inserting new commercials to original commercials with the recorded program (Column 14, lines 1-12, Column 12, lines 54-59) included in the recorded program interpreted which is met by some commercials or advertisements are overwritten based on timewise data (Column 14, lines 1-12) and b) replacing or substituting for the original commercial information included in the recorded program (Column 14, lines 1-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to the combination to include Zigmond's any recording medium comprising recording substitution means obtaining advertising information appropriate for a user attribute of the requesting origin by the connection means (Figure 5, Figure 6, Column 7, lines 9-12, Column 11, lines 31-65, Figure 4, 62, 66, Column 9, lines 39-55) and one of a) inserting into the recorded program (Figure 5, Figure 6, Column 7, lines 9-12, Column 11, lines 31-65) in addition to original commercial information or any commercials that an advertiser can specify to be shown during a particular program included in the recorded program some commercials or advertisements are overwritten based on timewise data (Column 14, lines 1-12, Column 12, lines 54-9) and b) replacing or substituting for the original commercial information

included in the recorded program (Column 14, lines 1-12) to the external device (any recording medium) of the combination in order to provide advertisements that are more interesting to the viewer for premium payment from the advertiser (Column 1, lines 23-35) as disclosed by Zigmond.

Furthermore, the *KSR* Court found that if all the claimed elements are known in the prior art then one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yield predictable results to one of ordinary skill in the art at the time of the invention. *KSR*, 82 USPQ2d at 1395.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda in view of Lawler and Ellis, as applied to Claim 8, further in view of Zigmond.

Regarding Claim 11, Kuroda, Lawler and Ellis disclose all the limitations of Claim 8. Kuroda discloses receiving and recording television programs in the storage means or the external device, which necessarily includes commercials. Lawler discloses connection means for connecting via a wide area network with an external storage device which is external to the recording system (Column 5, lines 28-31, Figure 1, 14, Column 12, lines 29-31, 58-61, Column 13, 8-12, 26-36), issue portion for issuing a recording request to the external storage device for recording the program via the wide network by the connection means (Column 12, lines 29-31, 58-61, Column 13, lines 8-12, 26-36). Lawler discloses external device includes user information management means (Column 13, lines 8-12, 26-36). Kuroda and Lawler is silent on a recording

medium obtaining advertising information appropriate for a user attribute of the requesting origin via the connection means and one of a) inserts the advertising information in a recorded program stored in the storage means in addition to original commercial information included in the recorded program and b) substitutes the advertising information for the original information in the recorded program.

In analogous art, Zigmond discloses any recording medium comprising recording substitution means obtaining advertising information appropriate for a user attribute of the requesting origin by the connection means (Figure 5, Figure 6, Column 7, lines 9-12, Column 11, lines 31-65, Figure 4, 62, 66, Column 9, lines 39-55). Zigmond discloses recording substitution means (ad insertion device performing ad insertion via repository and switching unit) (Figure 5, Column 15, lines 24-27, 31-34) configured to one of a) inserting the advertising information in a recorded program in addition to original commercial information or any commercials that an advertiser can specify to be shown during a particular program and only some commercials have to be replaced in a recorded program so inserting new commercials to original commercials with the recorded program (Column 14, lines 1-12, Column 12, lines 54-59) included in the recorded program interpreted which is met by some commercials or advertisements are overwritten based on timewise data (Column 14, lines 1-12) and b) replacing or substituting for the original commercial information included in the recorded program (Column 14, lines 1-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Zigmond to include any recording medium comprising recording substitution means obtaining advertising

information appropriate for a user attribute of the requesting origin by the connection means (Figure 5, Figure 6, Column 7, lines 9-12, Column 11, lines 31-65, Figure 4, 62, 66, Column 9, lines 39-55) and one of a) inserting into the recorded program (Figure 5, Figure 6, Column 7, lines 9-12, Column 11, lines 31-65) in addition to original commercial information or any commercials that an advertiser can specify to be shown during a particular program included in the recorded program some commercials or advertisements are overwritten based on timewise data (Column 14, lines 1-12, Column 12, lines 54-9) and b) replacing or substituting for the original commercial information included in the recorded program (Column 14, lines 1-12) to the external device (any recording medium) of the combination of Lawler and Kuroda in order to provide advertisements that are more interesting to the viewer for premium payment from the advertiser (Column 1, lines 23-35) as disclosed by Zigmond.

Furthermore, the *KSR* Court found that if all the claimed elements are known in the prior art then one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yield predictable results to one of ordinary skill in the art at the time of the invention. *KSR*, 82 USPQ2d at 1395.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FARZANA HOSSAIN whose telephone number is (571)272-5943. The examiner can normally be reached on Mondays and Wednesdays, 8:00 am to 2:30 pm, Tuesdays, Thursdays and Friday 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pankaj Kumar can be reached on 571-272-3011. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/FARZANA HOSSAIN/
Primary Examiner, Art Unit 2424

May 7, 2011